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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,226	10/22/2001	Paul Kenneth Whittingham	13347US02	4979
7590	09/22/2005		EXAMINER	
McANDREWS, HELD & MALLOY, LTD. 34th Floor 500 W. Madison Street Chicago, IL 60661			EVANISKO, LESLIE J	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/986,226	WHITTINGHAM ET AL. <i>[Handwritten Signature]</i>
	Examiner	Art Unit
	Leslie J. Evanisko	2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 October 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 23-27 is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 March 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12-27-2004</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Priority***

1. It is noted that applicant states on page 1 of the specification that the present application is intended to be a continuation-in-part of another U.S. application. However, applicant fails to provide the appropriate serial no. for the application.
  
2. If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 120, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the

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specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR

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1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

### ***Drawings***

3. The replacement drawings were received on March 1, 2002. These drawings are approved by the Examiner. However, note these drawings include the following informalities:

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference numeral 50 in Figure 3A, reference numerals 132, 150, 154, and 156 in Figure 15, and reference numerals 192, 194 in Figure 24.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the

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immediate prior version of the sheet, even if only one figure is being amended.

Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. The disclosure is objected to because of the following informalities:

The brief description of the Figures provided on pages 3-6 of the specification have several informalities. In particular, the description of each of Figures 3, 5, 7, 9, 11, 13, and 22 are not consistent with the Figure labels since there are multiple figures (A and B) for each Figure numeral. For example, instead of Figure 3, the brief description should reference Figures 3A and 3B since that is what is illustrated in the drawings. Similarly note the references to these respective Figure numerals in the descriptions of Figures 4, 6, 8, 10, 12, 14, and 23 should also be corrected. Additionally, note the description of Figures 44A-B should actually be --Figs. 44A, 44B-1, and 44B-2-- to be consistent with what is shown in the drawings.

Additionally, on page 8, lines 29-30, the job controller server 30 described in the specification has not been illustrated in the drawings.

However, it is noted that there are a plurality of occurrences of reference numeral 32 in Figure 1, at least some of which appear to be designating different pieces of structure. In particular, it appears that the righthand-most occurrence of reference numeral 32 (appearing under reference numeral 10) should actually be --30-- since it appears to be designating the job controller server.

Appropriate correction and/or clarification is required.

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

7. Claims 2 and 8 are objected to because of the following informalities:

With respect to claim 2, the term "the reference number" in lines 2-3 has no proper antecedent basis since only a "reference" was previously recited in claim 1. Consistent terminology should be used throughout the claims.

With respect to claim 8, the term "the range" in lines 2-3 has no proper antecedent basis since the range was only previously recited in claim 7 and claim 8 depends upon claim 6. To correct this problem, it is suggested that

claim 8 be amended to depend upon claim 7 to provide proper basis for the term "the range".

Appropriate correction and/or clarification is required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are related to providing any clear relationship between the recited method steps and how this relationship results in a determination of the optimum number of plates to be used to produce the labels. Specifically, claims 1, 9 and 16 are unclear with respect to how the steps recited relate to one another and result in a determination of whether to increase the number of plates. For example, in claim 1, it is not clear how the first step of determining a minimum number of plates relates to the other two recited steps of determining a total run time number and comparing the run time number to a "reference". In particular, the claim as currently written merely recites that a determination of the minimum number of plates is made but fails to provide any further detail as to what or if that determination is used in determining how many plates to use.

Note similar problems occur in the first two and three steps recited in claims 9 and 16 respectively.

Furthermore, the comparison step in each claim in which the total run time number is compared to a “reference” is vague and indefinite, particularly with respect to what the reference value is and what information it provides to a user that results in the ability to determine whether to increase the number of plates.

Due to the extreme indefiniteness of claims 1-22, the Examiner is unable to determine the exact scope of these claims and therefore unable to examine these claims relative to the prior art at this time. An examination of these claims relative to the prior art will be completed when the claims are in proper compliance with 35 USC 112.

***Allowable Subject Matter***

10. Claims 23-27 are allowed.

11. The following is a statement of reasons for the indication of allowable subject matter:

With respect to claim 23 in particular, the prior art of record fails to teach or fairly suggest a method of determining an optimum number of plates to be used to print a predetermined number of labels having all of the method steps as recited, in combination with and particularly including, calculating values representing estimated production costs based on different numbers of

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plates used to print the labels and comparing these values to determine the number of plates to be used.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on M-Th 7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lje  
September 19, 2005

*Leslie J. Evanisko*  
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Primary Examiner  
Art Unit 2854